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| 09/703,459      | 10/31/2000  | Marc P. Schuyler     | 10005868-1          | 1881             |

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EXAMINER


JANVIER, JEAN D

ART UNIT PAPER NUMBER

3622

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |   |  |
|------------------------------|--------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/703,459 | <b>Applicant(s)</b><br>SCHUYLER, MARC P.  |  |
|                              | <b>Examiner</b><br>Jean D Janvier    | <b>Art Unit</b><br>3622   |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07/26/04.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **Response To Applicant's Amendment**

The Examiner approves the new abstract.

### **Response To Applicant's Arguments**

Applicant argues that Scroggie fails to disclose, teach or suggest generating a promotion associated with the vehicle maintenance event as recited in claim 1, for example, and thus, the inadequacy of Wezger (primary reference) is not satisfied by the modification suggested by the Office Action. In response, the Examiner respectfully and completely disagrees with the Applicant's findings. In general, the Applicant's arguments are incomplete and inaccurate. First of all, the Examiner uses the Scroggie's reference and a publicly disclosed and well known material to show respectively that providing a discount coupon redeemable on a product or service at a local store is taught in the prior art and providing a discount coupon redeemable on a potential, probable and future service to a customer is old and well established in the industry. Hence, an ordinary skilled artisan, implementing the Mezger's system, would have been motivated at the time of the invention without reading the Instant Application to incorporate the above disclosures (Scroggie and the publicly disclosed and well known material) into the vehicle diagnostic system of Mezger so as to provide to a customer or vehicle 11 owner a promotion or a discount coupon, from a local service provider or car dealer servicing an area proximate to the vehicle 11 owner's residence, redeemable on a service maintenance or repair at the local service provider's or car dealer's location subsequent to detecting a maintenance event or a faulty operation in vehicle 11 or to issue another discount coupon, applicable to a complimentary product or service unrelated to the current maintenance event, to the customer or owner of

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vehicle 11, wherein the promotion or discount coupon or the other discount coupon is mailed or e-mailed to the customer or owner of the identified vehicle 11 or an advisory note or token is transmitted to the customer to enable him to receive the associated benefit upon presenting the advisory note or token at the local service provider's or car dealer's repair location, thereby encouraging the customer or vehicle 11 owner to return to the dealer's shop or local service provider location to have vehicle 11 serviced or repaired for the current problem associated with the triggering maintenance event, or for other regular service maintenance, such as motor or transmission oil change, timing belt replacement or tune-up, etc., that is due or past due based upon the vehicle 11 odometer current reading and the manufacturer's criteria or recommendations and for other potential faulty operations or defects revealed as a result of a meticulous testing or inspection conducted at the workshop or dealer's shop or service provider's location or to acquire at least one related or complimentary item upon redeeming the other discount coupon at the workshop, while recording at the end of the service repair the current odometer reading, which is used not only to estimate or schedule the next routine service maintenance related to the vehicle 11, but also to further target the customer or the owner of the identified vehicle 11 by issuing at least one discount coupon to the customer, wherein the discount coupon is associated with the next scheduled routine service maintenance and wherein records stored in the programmable memory 22 coupled to the vehicle 11 onboard system and corresponding to the monitoring of the vehicle 11 operations can be utilized by the vehicle 11 manufacturer to study the vehicle 11 (being of a specific type and model) performance and to make recommendations for future models and to even recall if need be all vehicles 11 that may

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exhibit a common malfunction or defect in order to protect the public at large, as commonly practiced in the industry.

Therefore, the Applicant's request for allowance or withdrawal of the last Office Action has been fully considered and respectfully denied in view of the foregoing response since the Applicant's arguments as herein presented are not plausible and thus, the last Office Action, as shown below, is hereby maintained and the current **Office Action has been made Final**.

### **DETAILED ACTION**

#### *Specification*

#### *Claim Status*

Claims 1-11 are still pending in the Instant Application.

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mezger et al. (hereinafter Mezger), US Patent 5,781, 871 in view of Scroggie, WO 97/23838.

As per claims 1, 2, 6, 8, 10 and 11, Mezger discloses a system wherein an onboard controller 20 of fig. 2 installed in a vehicle 11 can detect the presence of a vehicle maintenance event or malfunction or faulty operation based on data collected from the vehicle operations meeting or reaching or exceeding a vehicle maintenance criteria or pre-established diagnostic or maintenance threshold values stored in the programmable memory 22 of the vehicle controller 20 and wherein the controller wirelessly transmits diagnostic data DD or the occurrence of the maintenance event or faulty operations including the vehicle ID or identifier to a remote central computer 10. It is further understood that the owner of the vehicle 11, upon acquiring or buying the vehicle at a dealer's, provides upon filling an application personal information, such as home and work addresses, home and work phone numbers, social security number, annual income, e-mail address, etc., wherein the social security number is used to conduct a credit report or credit check on behalf of the individual or customer and wherein the home address is used to contact the customer in the event of a recall or to send promotional materials including coupons on service maintenance to the customer, as practiced in the art. In other words, by extracting the vehicle 11 ID or identifier from the transmitted DD report (diagnostic data report), the customer associated with the vehicle 11 is being identified, wherein a notification can be sent to the customer to bring the vehicle to a local repair shop or workshop for inspection, maintenance service or repair. Furthermore, the central computer 10 can contact the vehicle 11 and call up the DD concerning the vehicle 11 at any point in time and if a faulty operation has been detected in

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the vehicle operation, then the vehicle 11 can be called into a workshop or service facility for service maintenance or repair or inspection (Col. 1: 57 to col. 2: 50; col. 3: 40-52; col. 3: 58 to col. 5: 65; figs. 1-3; claims 4, 6-8 and 10 of the present reference).

As per claims 1, 3-6, 8 and 9, Megzer does not expressly disclose generating a promotion related to the maintenance event or the detection of a faulty operation in vehicle 11, wherein the promotion represents at least one discount coupon, redeemable on the maintenance event or faulty operation, from a local service provider or workshop operator, capable of fixing the faulty operation or defect, servicing a geographic location proximate to the vehicle 11 owner residence, wherein another discount coupon, corresponding to the promotion, applicable on a product complimentary to the vehicle maintenance event or vehicle 11 faulty operation is being generated and wherein the promotion or the discount coupon on the maintenance event from the local service provider or the other discount coupon on the complimentary product is transmitted or e-mailed to the vehicle 11 owner.

However, Scroggie discloses an incentive distribution network or system for providing from a plurality of providers purchase incentive offers, such as electronic coupons, recipes, rebates, shopping aids, product samples, supermarket specials, etc. to qualified customers over the Internet or communications network. First of all, the customer logs into the system and fills out a registration form where he provides his demographic information including geographical location having a specific zip code and other postal code since the features of the present system are location-dependent. If it is determined by the system that the submitted zip code is a valid zip

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code, that is a zip associated with a retail store where an electronic coupon can be redeemed, then the system allows the customer to proceed to the main menu and browse among available purchase incentive offers. The system merges customer supplied-information 270 with other purchase incentive data 272 of fig. 12 and creates or customizes a printable graphical image of the purchase incentive 282 for transmission or delivery to the identified customer. In one alternate embodiment of the invention, the purchase incentive or electronic coupon is not directly transmitted to the customer, instead the terms of the purchase incentive or coupon, for example, are transmitted electronically to a retail store 310 of fig. 13, located in the customer's geographical location or zip code, pre-selected by the said customer, who receives either a token 316 or an advisory message to present at the retail store 310 during a redemption process.

(Receiving by the incentive distribution network coupon image or coupon data and target market characteristics or parameters from a manufacturer or product distributor interested in having their product promotions displayed or distributed on the incentive network, wherein the incentive distribution network stores the coupon image or coupon data and target market parameters as data in a database and wherein the coupon data are later retrieved and used to prepare a customized coupon image to be displayed to a qualified customer having specific characteristics, as specified by the manufacturer or product distributor, over a communications network).

(See abstract; page 10: 4 to page 11: 14; page 1: to page: 7: 6; page 16: 5 to page: 18: 18; figs. 1-5, 11-18).

In a further embodiment of the invention, incentives may be customized or targeted to a specific customer based on the customer's purchase history (previous purchase) 502 collected at



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a retailer's store after the sale of one or more products and provided to a product manufacturer or distributor or System Administrator system, and wherein the purchase history data comprising at least one product sold at the retailer's and wherein after this customization, by the manufacturer or provider or distributor of the product in conjunction with the retailer, the incentives are transmitted to consumer's computer 510 via electronic mail or e-mail address stored in a consumer database 506 storing customer's registration information or via a personal web page (electronic device) in the computer network established for each consenting consumer wherein the personal web page or electronic device is used to display the customized incentives to the user or customer whenever he/she logs into the network and wherein the web page is also customized, by the manufacturer in association with the retailer, using among other things the purchase history 502 collected at the retailer's store. Here, it is to be understood that the customized web page or electronic device will display on the user computer targeted incentives created specifically for the user based on the user demographic data, purchase history data and most of all based on information specific to the retailer, such as the location of one of his stores in the user's geographical area (See abstract; page 10: 4 to page 11: 14; figs. 1-5, 11-18; page 22: 2 to page 23: 2).

Moreover, the incentives, such as shopping aids, supermarket specials, retailer's offers, manufacturer's samples, sweepstakes, rebates, coupons, etc., are considered to be a form of advertisements for manufacturer's and retailer's products and wherein these incentives or product promotions or advertisements are downloaded by the user or customer in an interactive manner (page 6: 3-12; page 24: 3-6).

Further, in yet another embodiment, incentives may be targeted to specific customers based on a customer's purchase history (502) and transmitted to the consumers by e-mail using the customers' e-mail addresses stored in a consumer database (506). In other words, notification or indication of the availability of these incentives is transmitted to the customers in the form of Internet messages, for retrieval when the customers or consumers next access a web site associated with the system or check their e-mails. Finally, the incentive message informs a customer that one or more specific offers are available and can be received at a participating POS when the prerequisite products are purchased. Alternatively, subsequent to receiving an e-mail notification or an indication of an incentive offer, an image of a paper coupon may be transmitted to the customer's computer site and printed for later presentation at pre-selected POS (See abstract; page 9: 22-30; page 12: 23-25; page 13: 2-3; page 15: line 3-10; page 20: 2-8; page 20:16 to page 21: 30; figs 9 and 11-15).

Additionally, it is common practice for a car dealer, upon selling a car to a customer or servicing a customer's car, to collect customer's personal data, such home and work addresses, home and work phone numbers, social security number, annual income, e-mail address, etc., wherein in the case of a car purchase the social security number is used to conduct a credit report or credit check on behalf of the individual or customer for a loan approval or otherwise and wherein the home address is used to contact the customer in the event of a recall or to send promotional materials including coupons on service maintenance to the customer. In short, the dealer keeps record of the last odometer reader of the customer's car during the car purchase or service and estimates after a certain period of time when the car is due, for instance, for a motor

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oil change, transmission oil change, tune-up, timing belt change, etc., in accordance with the car manufacturer's recommendations requiring that the car receive a service maintenance based on the number of miles thus far recorded in order to keep the car in good operating condition. The dealer may also send discount coupons to the customer for services in accordance with the time of year. The dealer may also provide a discount coupon to a customer in an effort to encourage the identified customer to return to the dealer's service location for scheduled service maintenance and wherein the discount coupon is applicable on a product or service different from the scheduled maintenance service (complimentary product or service).

Finally, providing a discount coupon to a customer redeemable on a complimentary product is old and well established in the industry for many years (no further disclosure is necessary here).

Therefore, an ordinary skilled artisan, implementing the Mezger's system, would have been motivated at the time of the invention without reading the Instant Application to incorporate the above disclosures (Scroggie and the publicly disclosed and well known material) into the vehicle diagnostic system of Mezger so as to provide to a customer or vehicle 11 owner a promotion or a discount coupon, from a local service provider or car dealer servicing an area proximate to the vehicle 11 owner's residence, redeemable on a service maintenance or repair at the local service provider's or car dealer's location subsequent to detecting a maintenance event or a faulty operation in vehicle 11 or to issue another discount coupon, applicable to a complimentary product or service unrelated to the current maintenance event, to the customer or

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owner of vehicle 11, wherein the promotion or discount coupon or the other discount coupon is mailed or e-mailed to the customer or owner of the identified vehicle 11 or an advisory note or token is transmitted to the customer to enable him to receive the associated benefit upon presenting the advisory note or token at the local service provider's or car dealer's repair location, thereby encouraging the customer or vehicle 11 owner to return to the dealer's shop or local service provider location to have vehicle 11 serviced or repaired for the current problem associated with the triggering maintenance event, or for other regular service maintenance, such as motor or transmission oil change, timing belt replacement or tune-up, etc., that is due or past due based upon the vehicle 11 odometer current reading and the manufacturer's criteria or recommendations and for other potential faulty operations or defects revealed as a result of a meticulous testing or inspection conducted at the workshop or dealer's shop or service provider's location or to acquire at least one related or complimentary item upon redeeming the other discount coupon at the workshop, while recording at the end of the service repair the current odometer reading, which is used not only to estimate or schedule the next routine service maintenance related to the vehicle 11, but also to further target the customer or the owner of the identified vehicle 11 by issuing at least one discount coupon to the customer, wherein the discount coupon is associated with the next scheduled routine service maintenance and wherein records stored in the programmable memory 22 coupled to the vehicle 11 onboard system and corresponding to the monitoring of the vehicle 11 operations can be utilized by the vehicle 11 manufacturer to study the vehicle 11 (being of a specific type and model) performance and to make recommendations for future models and to even recall if need be all vehicles 11 that may

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exhibit a common malfunction or defect in order to protect the public at large, as commonly practiced in the industry.

**The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mezger and in view of Park, US Patent 5, 627, 549.

Although, as per claim 7, Mezger teaches a vehicle 11 having an onboard computer system having a traditional micro-processor, volatile memory or RAM and non-volatile memory or ROM or a hard disk drive to store records, however Mezger does not explicitly disclose the presence of a screen or display coupled to the vehicle 11 onboard computer system 20 for displaying a transmitted promotion or advertisement to the individual or the driver of vehicle 11.

However, Park discloses a system wherein a user or operator of mobile vehicle 10 can interact with an advertisement or promotional message (promotion) aired and transmitted (synchronized broadcast 22 and 26) by pressing the **where button 102(f)** in the front panel of information device 40 inside the mobile vehicle 10, which indicates to the microprocessor 60 of

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device 40 that the driver or operator desires to collect or to receive further information, such as the advertiser's name, address or location and so forth, from the broadcast 22 or transmitted or aired or played advertisement and wherein the requested information is displayed to the operator or driver of the vehicle on the device 40 screen 100a as shown in fig. 3. In other words, a broadcast or aired advertisement or promotion is being transmitted to the device 40 and displayed in the form of text on a display or screen 100a coupled to the device 40 installed inside the vehicle 10. Furthermore, by pressing stored information button 102g, the user can search a local database or customized local database of the device 40 storing data records for each geographic point of interest to the user including records associated with selective display of previously stored advertisements (activity log file), such as records related to the advertisement recently broadcast or just aired by broadcast system 20 and displayed on the vehicle information device 40 screen 100a following a request for more information by the user. In other words, the user constructs a personal reference tracking travel information comprising data records for particular geographic points of interest, data records selected, related to one or more displayed or aired advertisements, by the user and of interest to the user, thereby creating a user profile or user pattern based on the stored data records of geographic points of interest to the user and stored data records of previously selected or displayed advertisements and/or requests from the user for further information in response to currently played advertisements or broadcasts. Here, the user's request for more information in response to the playing of a synchronized broadcast, that is voice and text data, is similar to displaying text data related to the advertisement (see fig. 3). (Read on creating an activity log of displayed advertisements and creating a user's pattern or user's profile using the activity information and the user's request or simply creating a user

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pattern using data from the local customized database). (See Col. 6: 41-65; col. 6: 66 to col. 7: 11; col. 8: 34-51; figs. 3-6).

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention without reading the Instant Application to incorporate Park's teachings into the vehicle diagnostic system of Mezger so as to connect a screen or display to the vehicle 11 onboard computer system 20 and to transmit a promotion or advertisement to be displayed on the screen or display, wherein the promotion or advertisement may contain, among other things, information on a discount coupon redeemable on a service maintenance related to a triggering maintenance event or detection of a faulty operation in vehicle 11, thereby providing real-time service repair information to the customer conducted in a wireless mode, while encouraging he customer or driver to visit a local service provider to have his vehicle 11 repaired upon redeeming the coupon associated with the current service repair.

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

For information on the status of your case, please call the help desk at (703) 308-1113.

Further, the following fax numbers can be used, if need be, by the Applicant(s):

After Final- 703-872-9327

Before Final -703-872-9326

Non-Official Draft- 703-746-7240

Customer Service- 703-872-9325

A handwritten signature in black ink that reads "Janvier Jean Dario". The signature is written in a cursive, flowing style.

JDJ

09/22/04